UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/965,786 | 09/27/2001 | Rick Rowe | IGTECH.0028P | 3692 |

32856 7590 03/30/2005

WEIDE & MILLER, LTD.
7251 W. LAKE MEAD BLVD.
SUITE 530
LAS VEGAS, NV 89128

| EXAMINER | |
|---|---|
| COBURN, CORBETT B | |
| **ART UNIT** | **PAPER NUMBER** |
| 3714 | |

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8N

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/965,786 | ROWE ET AL. | |
| | Examiner | Art Unit | |
| | Corbett B. Coburn | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *03 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-5,7-10,13-16,19 and 21-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-10,13-16,19 and 21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/22/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 7-10, 13-16, 19 & 21-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US Patent Number 6,113,495).

**Claims 1, 8, 19, 23:** Walker teaches an information system associated with a gaming system including at least one gaming device (300), the gaming device is arranged to present at least one game for play thereon (slot machine game). There is a player tracking device (360) associated with said gaming device. The player tracking device including a card reader (364), a keypad (370), at least one speaker (353) and at least one display (346, 362). (Since all components are electrically connected and controlled by the CPU, they are part of the player tracking device – the physical location of the component in the cabinet is immaterial.) Walker teaches a player tracking host (110) arranged to store data regarding one or more players of said gaming device (in Player Tracking Database 400). The player tracking host (110) is also an information system host. The information system host is arranged to determine the eligibility of a player of said gaming device to multi-media information (Fig 7A, 715). Eligibility is determined from data regarding the player (Fig 4). The information system host is arranged to

generate multi-media information for presentation by said player tracking device of said gaming device based upon said eligibility. (Figs 7A-C & 8) The multi-media information may be video or one or more images for presentation upon said at least one display of said player tracking device and audio information for presentation by said at least one speaker of said player tracking device. (Col 7, 44-61) There is a communication link between said player tracking device and said player tracking host over which said generated information is transmitted. (Fig 1) The multimedia information may be presented independent of player activity (i.e., to all players on a particular class of machines.) (Col 2, 57-60) Walker teaches both the structure and the method of using it.

**Claims 2, 9, 24:** The information host is arranged to determine said eligibility in response to an indication from said player tracking host that a player has begun playing said gaming device. (Fig 8)

**Claim 3:** The communications link comprises a portion of a communication network. (Fig 1)

**Claim 4:** A plurality of player tracking devices associated with differing gaming devices are associated with said player tracking host. (Fig 1 & Col 3, 14-16)

**Claims 5, 13, 21:** The information host is adapted to generate information regarding a player promotion. (Information is provided as a "comp". Col 4, 27-34. Comps are player promotions.)

**Claim 7:** Fig 3 shows part of the player tracking device (360) in a separate box. The location of this box is immaterial, but it appears to be near the top of the machine. Furthermore, Walker '495 teaches that the multimedia content may be displayed on

display (362). (Col 7, 44-61) This would mean that the display would be at eye level – i.e., on the top of the device.

**Claim 10:** The indication comprises the transmission of player identification information from the player tracking device to the player tracking host. (Fig 7A, 705)

**Claims 14, 26:** The step of determining player eligibility comprises determining if said player has accrued a number of reward points. (Fig 4, 435 & Col 2, 57-60)

**Claims 15, 25:** The step of determining player eligibility may include determining if said player is playing a certain type of gaming device. (Col 2, 53-5)

**Claims 16, 22:** The multi-media information may include information regarding a bonus. The multimedia information may be used as a form of comp. Comps are a form of bonus.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 7-10, 13-16, 19 & 21-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 & 18-28 of copending Application No. 10/242559. Although the conflicting claims are not

identical, they are not patentably distinct from each other because they claim the identical structure and method for use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

5. Applicant's arguments filed 3 February 2005 have been fully considered but they are not persuasive.

6. Applicant argues that Walker fails to teach a player tracking system with a speaker. Figure 3 shows an audio speaker (353) that is part of the player tracking system. Player tracking device (360) is tied to CPU (310) and audio speaker (353) – they are one system. If Applicant intends to limit his invention to the mere physical placement of the speaker on a particular circuit board, then Applicant should amend the claims to so state. Such an amendment would overcome the §102 rejection – though a §103 rejection would be immediately forthcoming as the mere rearrangement of parts is considered obvious.

7. Applicant argues that Walker fails to teach a player tracking system with a display for presentation of multimedia information. Walker teaches two such displays (362 & 346). As noted in regard to the speaker, these displays are currently part of the player tracking system. All components are controlled by the same CPU. Again, if Applicant wishes to claim the attachment of a display to a particular circuit board, then Applicant should amend the claims to do so.

8. Applicant argues that a menu is not multimedia content. Examiner has seen any number of menus that contain graphical or multimedia elements. Furthermore, the rejection does not

limit the display of the multimedia to display (362). As pointed out above, Video Display Area (346) is also part of the player tracking system. It clearly is intended to display video images.

9. In general, Applicant is arguing that the physical location of electrical components within a system is dispositive. This is not commensurate with the scope of the claims. Walker teaches a player tracking device with the required elements. They are clearly interconnected (as shown in Fig 3) and are all controlled by the CPU (310). This makes them a single system. The fact that one or more elements may have a different physical location in the cabinet than Applicant discloses (but does not claim) is not germane to the issue of patentability. The fact that the CPU controls other components (such as slot machine reels) is also moot. Applicant's claims are open ended. If Applicant intends to narrow the claims to include the physical location of electrical components, or to preclude the attachment of other components, then Applicant must amend the claims to reflect that change in scope.

10. Applicant states that there is no support for the contention that player tracking host is an information system host. Figure 2 clearly shows a system with a CPU, RAM, ROM, databases – including a content database, and communications ports. This is clearly a computer or "information system". Applicant's contention that the player tracking host and the information system host must be two separate pieces of hardware is not commensurate with the scope of the claims.

11. Applicant argues that the physical location of the device (i.e., on a top box) is dispositive to the question of patentability. Applicant is arguing that "top box" is a term of art. Yet Applicant did not define "top box" within the specification. Furthermore, if Examiner accepted Applicant's current definition, it is evident from Walker's disclosure that the video screen would

necessarily be located in a "top box". It could not go under the slot machine because it could not be seen. Slot machines do not have video displays to either side of the reels – that distracts from the game. Therefore the only location left for the video screen is on top of the slot machine game – i.e., in a "top box".

12. Applicant argues that Walker fails to teach either transmitting the multimedia information to the player tracking system or storing the multimedia information. As pointed out above, the entire device depicted in Fig 3 is a player tracking device. Walker is perfectly clear that multimedia data is transmitted to this device. It is also impossible for the device depicted in Fig 3 to play that multimedia data without storing it in memory. During the playing of this multimedia information, the system must periodically access the information – the CPU must read it from memory in order to display it.

13. Applicant states that a terminal disclaimer will be forthcoming when and if this is ready for issue. The double patenting rejection cannot be withdrawn until the terminal disclaimer is actually submitted.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

JESSICA HARRISON
PRIMARY EXAMINER